



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/557,878	04/24/2000	Mike Jensen	SOPP 301B	8914

23581 7590 08/19/2002

KOLISCH HARTWELL DICKINSON MCCORMACK &
HEUSER
520 S.W. YAMHILL STREET
SUITE 200
PORTLAND, OR 97204

EXAMINER

VAN DOREN, BETH

ART UNIT PAPER NUMBER

3623

DATE MAILED: 08/19/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/557,878

Applicant(s)

JENSEN, MIKE

Examiner

Beth Van Doren

Art Unit

3623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 April 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. The following is a non-final, first office action. Claims 1-9 are pending.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-9 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-7 of U.S. Patent No. 6,065,000. Although the conflicting claims are not identical, they are not patentably distinct from each other due to the following reasons:

4. Claim 1 of the instant application is not patentably distinct from claim 1 of the patented invention because the only modifications present between the claims is the specificity of the safety information, the specificity of the information housed in the defined entry lists in the system database, and the specificity of the types of reports being created. Claim 1 of the instant application recites the limitation, "process of reporting safety information", "the system database including a plurality of defined lists of entries for selected variables and a plurality of defined formats for selected incident reports", whereas in column 14, lines 63-67, and column 15, lines 14, of the patented invention, claim 1 reads, "process of reporting injured-worker safety

Art Unit: 3623

information”, “the system database including a plurality of defined lists of entries for selected injury-worker-related items including information necessary to comply with governmental injured-worker-reporting regulations, and a plurality of defined formats for selected incident reports including an OSHA 200 report”. It would have been obvious to one of ordinary skill in the art, in light of the specifications provided by the applicant in the instant application and in U.S. Patent No. 6,065,000, that the safety information and the variables disclosed in claim 1 of the instant application include injured-worker safety information and injury-worker-related items including information necessary to comply with governmental injured-worker-reporting regulations, respectively, as per claim 1 of the ‘000. In re Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970), states that portions of the specification which provide support for the patent claims may also be considered when addressing the issues of whether a claim in the application defines an obvious variation of an invention claimed in a patent. Looking to the specification of the ‘000, column 1, lines 13-15, 19-26, and 55-67, and column 2, lines 1-2, disclose creating and storing defined lists of selected variables and receiving entries into these lists, the selected variables including selected injury-worker-related items including information necessary to comply with governmental injured-worker-reporting regulations. The specification of the instant application discloses the same information in page 1, lines 14-18, and page 2, lines 5-14.

Furthermore, it would have been obvious to one of ordinary skill in the art, in light of the specifications provided by the applicant in the instant application and in U.S. Patent No. 6,065,000, that the selected incident reports disclosed in claim 1 of the instant application include the OSHA 200 report of claim 1 of U.S. Patent No. 6,065,000. The OSHA 200 is an old and well-known agency-related format for gathering and presenting injury-related worker

Art Unit: 3623

information. Using the logic of *in re Vogel*, disclosed above, column 1, lines 34-40, and column 2, lines 6-7, of the '000 disclose the OSHA 200 as an old and well-known incident report format. The specification of the instant application also discloses this in page 1, lines 22-26, and in page 2, lines 15-17.

Hence, modifying the '000 that uses injury-worker safety information and selected injury-worker-related items including information necessary to comply with governmental regulations to instead use generic safety information and generic variables, in which the specific items would be included, and modifying the '000 that includes the specific report format of the OSHA 200 to include generic report formats, in which the OSHA 200 would be included, is respectfully considered obvious to one of ordinary skill in the art at the time of the invention.

5. In reference to claim 2 of the instant application, claim 2 is verbatim claim 2 of U.S. Patent No. 6,065,000.

6. In reference to claim 3 of the instant application, claim 3 is not patentably distinct from claim 3 of the patented invention because the only modification present between the claims is the specificity of the types of incidents included in the defined list. Claim 1 of the instant application recites, "include a defined list of types of incidents", whereas in column 15, lines 21-22, of the patented invention, claim 3 reads, "include a defined list of types of injured-worker incidents". It would have been obvious to one of ordinary skill in the art, in light of the specifications provided by the applicant in the instant application and in U.S. Patent No. 6,065,000, that the incidents disclosed in claim 1 of the instant application includes the injured-worker incidents of claim 3 of U.S. Patent No. 6,065,000. Using the logic of *in re Vogel*,

Art Unit: 3623

disclosed above, column 1, lines 13-26, of the '000 define incidents as injured-worker related incidents. The specification of the instant application also discloses this in page 1, lines 10-18.

Hence, modifying the '000 that uses injured-worker incidents to instead use general incidents, in which the specific incidents would be included, is respectfully considered obvious to one of ordinary skill in the art at the time of the invention.

7. Claim 4 of the instant application is not patentably distinct from claim 1 of the patented invention because the only modifications are the specificity of the safety information and the specificity of the information housed in the defined entry lists in the system database. Claim 1 of the instant application recites the limitation, "process of reporting safety information", "the system database including a plurality of defined lists of entries for selected variables", whereas in column 14, lines 63-67, and column 15, lines 1-2, of the patented invention, claim 1 reads, "process of reporting injured-worker safety information", "the system database including a plurality of defined lists of entries for selected injury-worker-related items including information necessary to comply with governmental injured-worker-reporting regulations". It would have been obvious to one of ordinary skill in the art, in light of the specifications provided by the applicant in the instant application and in U.S. Patent No. 6,065,000, that the safety information and the variables disclosed in claim 1 of the instant application include injured-worker safety information and injury-worker-related items including information necessary to comply with governmental injured-worker-reporting regulations, respectively, as per claim 1 of the '000. The reasons for the obviousness of this modification are provided above in the comments directed towards claim 1 of the instant application. Hence, modifying the '000 that uses injury-worker safety information and selected injury-worker-related items including information necessary to

Art Unit: 3623

comply with governmental regulations to instead use generic safety information and generic variables, in which the specific items would be included, would be included, is respectfully considered obvious to one of ordinary skill in the art at the time of the invention.

8. In reference to claim 5 of the instant application, claim 5 is verbatim claim 4 of U.S. Patent No. 6,065,000.

9. In reference to claim 6 of the instant application, claim 6 is verbatim claim 5 of U.S. Patent No. 6,065,000.

10. Claim 7 of the instant application is not patentably distinct from claim 6 of the patented invention. In re Karlson, 136 USPQ 184 (CCPA 1963), states that the omission of an element and its function is an obvious expedient if the remaining elements perform the same function as before. While elements of claim 6 in the '000 have been omitted in claim 7 of the instant application, the remaining elements accomplish the same function as before, that being the creation of a database of employee and incident information, the creation of an incident database that relates employees to specific incidents that have occurred, and the formatting and production of a report reflected these incidents. The information concerning these steps has been fully disclosed in both the specifications of the '000 and the instant application. Therefore, examiner respectfully asserts that the modifications made between these claims would have been obvious to one of ordinary skill in the art at the time of the invention. These modifications are discussed more fully below.

Claim 7 of the instant application recites the limitation, "creating a company database stored in computer memory, the company database including a defined list of employees and a defined list of types of incidents", whereas in column 15, lines 38-44, and column 16, lines 2-3,

Art Unit: 3623

claim 6 recites, “creating a system database stored in computer memory, the system database including a plurality of defined lists of entries for selected injured-worker-related items including worker name and information necessary to comply with governmental injured-worker-reporting regulations”. Both the instant application and the ‘000 include a database on the system associated with the company, plural defined lists of entries concerning selected items, those items including a list of employees (i.e. worker names) and list of types of incidents (i.e. information necessary to comply with governmental injured-worker-reporting regulations). The specifications of both the current application and the patented invention disclose the list of employees as worker names, the information necessary to comply with governmental regulations as that of types of incidents, and the company database as a system database in column 1, lines 19-26 and 62-67, and column 3, lines 58-67, and in page 1, lines 11-18, page 2, lines 9-11, and page 5, lines 3-9. In re Vogel. Furthermore, the use word including renders the claims open-ended, and therefore the claims contain, but are not limited to the elements presented. The specification of both the ‘000 and the instant application cite other elements incorporated into the database in column 4, lines 40-58, and column 5, lines 30-44, and in page 6, lines 5-16, and page 7, lines 11-20, respectively. Therefore, modifying the ‘000 to use the language of the current application is respectfully considered obvious to one of ordinary skill in the art at the time of the invention.

Claim 7 of the instant application also recites the limitation “selecting an employee from the company database”, “selecting a type of incident from the company database” and “creating an incident database stored in computer memory by inserting the selected employee and type of incident into a data record”, whereas in column 16, lines 2-9, claim 6 recites “creating an

Art Unit: 3623

injured-worker incident database stored in computer memory by selecting an entry from one or more of the defined lists in the system database and inserting the selected entry or entries into a data record". The elements of claim 7 of the current application and the elements of claim 6 of the '000 accomplish the same result. Therefore, the variations in the language of the limitations would have been obvious to one of ordinary skill in the art at the time of the invention.

Furthermore, claim 7 of the instant application recites "formatting the incident database into a report", whereas in column 16, lines 9-14, claim 6 recites "creating an injured-worker incident report that includes regulatory-required injured worker information by: selecting one of the defined formats from the system database; extracting and manipulating information from the incident database as defined in the selected format". The specification of pending application discloses the mode of formatting the incident database into a report as the creating an injured-worker incident report that includes regulatory-required injured worker information by selecting one of the defined formats from the system database and extracting and manipulating information from the incident database as defined in the selected format on page 1, lines 10-20, page 2, lines 5-9, page 4, lines 18-21 and 27, page 5, lines 4-26. Therefore, while the language of these limitations is not identical, they accomplish the same result and perform the same function, and therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to make these modifications. In re Karlson.

Both claim 7 of the current application and claim 6 of the patented invention recite the limitation "producing the report on a computer output medium".

Based on the discussion above, examiner respectfully asserts that claim 7 is an obvious modification of claim 6 in light of In re Vogel and In re Karlson. Hence, modifying the '000 to

Art Unit: 3623

exclude elements while still producing the same functional result would have been obvious to one of ordinary skill in the art at the time of the invention.

11. In the instance of claim 8, claim 8 of the application is not patentably distinct from claim 7 of the patented invention because the only modification present is the format in which the elements of the instant application are written. While the format of claim 8 of the instant application differs from the format of claim 7 of the patented invention, the function produced remains the same, that being the creating of a system database stored in computer memory that includes a plurality of defined lists of selected items and defined lists of report formats for producing selected incident reports, the creating of an incident database that includes one or more defined lists of incident records through the selection, extraction, and insertion of entries of select data records, and the creating of a report through the selection of a previously defined report format, the extracting and manipulation of information from the incident database as defined in the selected format, and the output of the report on computer output medium. Therefore the hypothetical patenting of instant claim 8 would improperly extend the patent rights granted claim 7 of the patented invention. The modifications of format are discussed more fully below.

Claim 8 of the instant invention recites the limitation “the system database including a plurality of defined lists of systems records of selected variables” and “a plurality of defined report formats for producing selected incident reports”, whereas in column 16, lines 20-27, claim 7 recites, “the system database including a plurality of defined lists of entries for selected injured-worker-related items including information necessary to comply with governmental injured-worker-reporting regulations” and “a plurality of defined graphical report formats for

Art Unit: 3623

producing injured-worker information regarding a plurality of workers". The terms that differ in these limitations are defined synonymously in the specifications of the instant application and the patented invention in page 1, lines 14-18, and page 2, lines 5-19, and in column 1, lines 13-15, 19-26, and 55-67, and column 2, lines 1-10. In re Vogel. Therefore, examiner respectfully submits that these would have been obvious modifications to one of ordinary skill in the art at the time of the invention.

Also, claim 8 of the instant application recites the limitations, "a system entry selector for selecting one or more of the defined system records", "an information extractor for extracting one or more of the variables from the selected system record", and "an incident database stored in computer memory, the incident database including one or more defined lists of incident records, wherein each incident record describes one or more aspects of a specific incident", whereas in column 16, lines 28-32, claim 7 recites, "creating an injured-worker incident database stored in computer memory by selecting an entry from one or more of the defined lists in the system database, and inserting the selected entry or entries into a data record". While the language used in the claims differs, the elements disclosed in claim 8 of the instant application are substantially the same invention with the same functionality as the elements of claim 7 of the patented invention. Therefore, since the two sets of elements perform the same functioning, it would have been obvious to one of ordinary skill in the art at the time of the invention to vary the language in this way.

While elements of claim 7 in the '000 have been omitted in claim 8 of the instant application, the remaining elements perform the same function, as shown above. Claim 7 of the patented invention recites "and further including an OSHA 200 report" and "creating a graphical

Art Unit: 3623

report that includes regulatory-required injured-worker information regarding a plurality of worker" in column 16, lines 23-24 and 33-35, respectfully. In re Karlson, 136 USPQ 184 (CCPA 1963), states that the omission of an element and its function is an obvious expedient if the remaining elements perform the same function as before. Therefore, the omission of these elements of claim 7 of the '000 in claim 8 of the instant application is respectfully considered obvious to one of ordinary skill in the art at the time of the invention.

Furthermore, claim 8 of the instant application is merely a system version of the computer-implemented process presented in claim 7 of the '000. Looking to the specification of the instant application, there is no disclosure as to any specific physical component that makes up the recited systems components (i.e., hardware logic constructs) for performing the recited steps. Since the specification provides nothing more than a system that is a network implemented method, and the system performs the same function as the computer-implemented process, examiner respectfully submits that the modification of claim 7 of the patented invention to a system would be considered obvious to one of ordinary skill in the art at the time of the invention.

12. As per claim 9 of the instant application, claim 9 further limits claim 8 through the inclusion of a user interface, an input form database including a plurality of input forms, an input form selector, and an input form formatter for extracting and manipulating information. The inclusion of these elements are merely creating a broader version of claim 8 above. Input forms are the means of the invention for creating and modifying lists of the database, as disclosed in the patented invention in column 1, lines 55-60, and the instant application in page 2, lines 5-8. In re Vogel. Therefore, input forms include input forms for the systems records of selected variables

Art Unit: 3623

of claim 8 of the instant application and input forms for the entries of selected-injured-worker related items of claim 7 of the '000. Therefore, modifying the '000 that uses specific input forms to instead use generic input forms would respectfully be considered obvious to one of ordinary skill in the art at the time of the invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Beth Van Doren whose telephone number is (703) 305-3882. The examiner can normally be reached on M-F, 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on (703) 305-9643. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

bvd
bvd

August 12, 2002


TARIQ R. HAFIZ
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600